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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,945	06/15/2001	Victor Lyamichev	FORS-04586	9139
23535	7590	11/20/2002	EXAMINER	
MEDLEN & CARROLL, LLP 101 HOWARD STREET SUITE 350 SAN FRANCISCO, CA 94105			CHAKRABARTI, ARUN K	
ART UNIT		PAPER NUMBER		
1634		DATE MAILED: 11/20/2002		14

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No. 09/882,945	Applicant(s) Lyamichev
Examiner Arun Chakrabarti	Art Unit 1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

1)  Responsive to communication(s) filed on Oct 3, 2002

2a)  This action is FINAL. 2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4)  Claim(s) 1-51 is/are pending in the application.

4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-43 is/are rejected.

7)  Claim(s) \_\_\_\_\_ is/are objected to.

8)  Claims 44-51 are subject to restriction and/or election requirement.

### Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on Jun 15, 2001 is/are a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.

12)  The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All b)  Some\* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a)  The translation of the foreign language provisional application has been received.

15)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_

4)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of Group I, corresponding to claims 1-43, in Paper No. 13 is acknowledged.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 10-18, 22-31, and 35-43 are rejected under 35 U.S.C. 102 (b) as being anticipated by Kim et al. (U.S. Patent 5,846,723) (December 8, 1998).

Kim et al teach a method for selecting a primer (Example 1), comprising:

a) providing:

I) a target nucleic acid having at least one accessible site and at least one inaccessible site (Column 11, lines 4-16 and Claims 1 and 21);  
ii) a plurality of extension primers, each of the primers comprising a first region, wherein the first region of the plurality of primers differ in sequence from each other, and

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wherein the plurality of primers comprise first regions that are complementary to different portions of the target nucleic acid (Example 1 and Claim 36); and

iii) a template-dependent nucleic acid extension agent (Example 1, Column 11, line 30 to Column 12, line 19) and ;  
b) exposing the plurality of extension primers and the extension agent to the target nucleic acid under conditions wherein primers comprising first regions that are complementary only to an inaccessible site in the target nucleic acid are not extended by the extension reagent, and wherein primers comprising first regions that are complementary to at least one accessible site of the target nucleic acid from an extension product (Example 1 and Figure 1);  
c) selecting a primer complementary to at least one accessible site by identifying a member of the plurality of primers that forms an extension product (Example 1 and claims 26-29).

Kim et al teach a method, wherein the target nucleic acids comprise DNA and RNA (Examples 1 and 2 and Column 10, lines 5-9 and Claim 37).

Kim et al teach a method, wherein the plurality of primers further comprise a second region, the second region located 5' of the first region (Claim 36).

Kim et al teach a method, wherein the second regions of the plurality of primers, are identical in sequence to one another (Claim 36)

Kim et al teach a method, further comprising providing:

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I) first and second amplification primers, the first amplification primer complementary to at least a portion of the second regions of the plurality of extension primers and the second amplification primer capable of hybridizing to a sequence complementary to a first domain of the target nucleic acid (Claim 36); and

ii) an amplification agent;

and further comprising the step of treating the extension products with the first and second amplification primers and the amplification agents to produce amplification products prior to the selecting step (Example 1 and Figure 1 and Column 11, line 30 to Column 12, line 19)

Kim et al teach a method, wherein the plurality of primers comprise a sufficient number of primers to encompass every sequence variation within the first region (Examples 1 and 2 and Claim 36 and Claims 21-23).

Kim et al teach a method, wherein the first region is six or more nucleotides in length (Claim 36).

Kim et al teach a method, wherein the template-dependent nucleic acid extension agent comprises a polymerase and reverse transcriptase (Example 1, Column 11, line 30 to Column 12, line 19)

Kim et al teach a composition comprising an oligonucleotide, the oligonucleotide comprising a sequence of a first region of a selected primer (Table II and Claim 36).

Kim et al teach a method for identifying and locating accessible sites on a target nucleic acid (Abstract and Example 2) comprising:

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a) providing:

I) a target nucleic acid having at least one accessible site and at least one inaccessible site (Example 2 and Column 11, lines 4-16 and Claims 1 and 21);  
ii) a plurality of extension primers, each of the primers comprising a first region, wherein the first region of the plurality of primers differ in sequence from each other, and wherein the plurality of primers comprise first regions that are complementary to different portions of the target nucleic acid, and wherein the second region is located 5' of the first region (Examples 1 and 2 and Claim 36); and

iii) a template-dependent nucleic acid extension agent (Examples 1 and 2 and , Column 11, line 30 to Column 12, line 19) ; and  
iv) an amplification agent (Examples 1 and 2 and , Column 11, line 30 to Column 12, line 19 and Claims 11-12)

b) exposing the plurality of extension primers and the extension agent to the target nucleic acid under conditions wherein primers comprising first regions that are complementary only to an inaccessible site in the target nucleic acid are not extended by the extension reagent, and wherein primers comprising first regions that are complementary to at least one accessible site of the target nucleic acid from an extension product (Examples 1 and 2 and Figure 1);

c) treating the extension products with the amplification agent and the first and second amplification primers to generate one or more amplification products, the amplification products having a length, wherein the length of the amplification products provide a distance of an

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accessible site on the target nucleic acid from the first domain of the target nucleic acid (Example 1 and claims 26-29 and Figure 1); and

d) determining a location of one or more accessible sites on the target nucleic acid using the distance (Examples 1 and 2 and Claims 25 and 34).

Kim et al teach a method, wherein the using the distance comprises determining the size of one or more of the amplification products (Claim 34 and Example 2).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CAR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later

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invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 7-9, 19-21, and 32-34 are rejected under 35 U.S.C. 103(a) over Kim et al. (U.S. Patent 5,846,723) (December 8, 1998).

Kim et al. teaches the method of claims 1-6, 10-18, 22-31, and 35-43 as described above.

Kim et al. does not specify the number of different primers in the range of 10 to 1000.

However, it is *prima facie* obvious that selection of the specific number of different primers represents routine optimization with regard to the requirement of screening of the number of primers and also on the length of the accessible sites of the target nucleic acids which routine optimization parameters are explicitly recognized to an ordinary practitioner in the relevant art. As noted *In re Aller*, 105 USPQ 233 at 235,

More particularly, where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.

Routine optimization is not considered inventive and no evidence has been presented that the specific number of different primers selection performed was other than routine, that the products resulting from the optimization have any unexpected properties, or that the results should be considered unexpected in any way as compared to the closest prior art.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from

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the examiner should be directed to Arun Chakrabarti, Ph.D. whose telephone number is (703) 306-5818. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. Any inquiry of a general nature or relating to the status of this application should be directed to the Group analyst Chantae Dessau whose telephone number is (703) 605-1237. Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission via the P.T.O. Fax Center located In Crystal Mall 1. The CM1 Fax Center numbers for Technology Center 1600 are either (703) 305-3014 or (703) 308-4242. Please note that the faxing of such papers must conform with the Notice to Comply published In the Official Gazette, 1096 OG 30 (November 15, 1989).

Arun Chakrabarti

Patent Examiner

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October 17, 2002

  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600